

REMARKS

In this Response, Applicant cancels claims 13-20, amends claims 1-3, 5-9, 11, 12, 21-24, and 26, adds new claims 30-47, and addresses the rejections set forth by the Examiner. Cancellations of and amendments to the claims are being made solely to expedite prosecution of the present application and do not constitute an acquiescence to any of the Examiner's rejections. Support for the amendments to the claims can be found throughout the application. Applicant reserves the option to further prosecute the same or similar claims in the present or a subsequent application. Upon entry of the Amendment, claims 1-12 and 21-47 are pending in the present application.

Color Photographs

Applicant notes that a Petition under 37 C.F.R. § 1.84(a)(2) to Accept Color Photographs was filed on September 17, 2003 in the present application. Applicant has not yet been informed, however, of the status of the Petition.

Applicant respectfully requests that the Examiner advise the Applicant of the status of the Petition in the next Office Action or contact the undersigned if additional information is required.

Claim Rejections

35 U.S.C. §§ 102(b), 103(a)

In the Office Action, the Examiner rejected claims 1-20, 23, 24, 26, 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Muhr-Sweeney in view of Tobol.

The Examiner also rejected claims 21, 22, 25, and 28 under 35 U.S.C. § 102(b) as being anticipated by Muhr-Sweeney.

Claims 1-6

Independent claim 1 of the present application is directed to a document with debris-removing characteristics. Among other things, the document includes a substrate having a first face and an opposing second face, in which at least a portion of the first face is capable of receiving printing indicia and at least a portion of the second face has a debris-removing coating applied thereon. The debris-removing coating is configured to remove printer debris during

passage of the document through a printer for printing the printing indicia upon the at least a portion of the first face.

Neither Muhr-Sweeney nor Tobol discloses, among other things, a substrate having at least a portion of a first face capable of receiving printing indicia. As recognized by the Examiner in the Office Action, Muhr-Sweeney “does not teach a printing indicia which is printed on the surface of the document or the sheet.” The Examiner therefore cites Tobol and states that “Tobol ... teaches a printing indicia 108 printed on the surface of the cleaning sheet 100.” Applicant respectfully disagrees with the observations of the Examiner. In contrast to the observations of the Examiner, Tobol does not disclose a cleaning sheet capable of receiving printing indicia, let alone the debris-removing substrate as claimed. At most, Tobol discloses a logo 108 that is embossed or pressed into, rather than printed on, a cleaning cloth 100. (Tobol col. 4, ll. 46-49 and Fig. 1.) Accordingly, neither Muhr-Sweeney nor Tobol, whether considered separately or in combination, discloses each and every feature of independent claim 1.

As such, Applicant respectfully submits that independent claim 1 is allowable over the prior art of record. Because independent claim 1 is allowable, claims 2-6 are also allowable at least for depending therefrom.

Moreover, dependent claims 2-6 are further allowable for reciting additional features not disclosed by the prior art relied upon by the Examiner. For example, claims 2 and 5 recite specific features of the substrate and claims 3, 4, and 6 recite specific features of the composition of the debris-removing coating, which are not disclosed by the prior art relied upon by the Examiner. At least for these reasons, dependent claims 2-6 are further allowable over the prior art relied upon by the Examiner.

Claims 7-12

Independent claim 7 of the present application is directed to a method for producing a document including providing a document having a first face and an opposing second face, in which at least a portion of the first face is capable of receiving printing indicia, and applying a debris-removing coating on at least a portion of the second face to remove printer debris during passage of the document through a printer for printing the printing indicia upon the at least a portion of the first face.

As previously provided herein, neither Muhr-Sweeney nor Tobol discloses a debris-removing document including, among other things, a substrate having at least a portion of a first face capable of receiving printing indicia. Because neither Muhr-Sweeney nor Tobol discloses a substrate having at least a portion of a first face capable of receiving printing indicia, neither Muhr-Sweeney nor Tobol discloses a method of providing such a document as claimed. Accordingly, neither Muhr-Sweeney nor Tobol, whether considered separately or in combination, discloses each and every feature of independent claim 7.

As such, Applicant respectfully submits that independent claim 7 is allowable over the prior art of record. Because independent claim 7 is allowable, claims 8-12 are also allowable at least for depending therefrom.

Moreover, dependent claims 8-12 are further allowable for reciting additional features not disclosed by the prior art relied upon by the Examiner. For example, claims 8 and 11 recite specific features of the document and claims 9, 10, and 12 recite specific features of the composition of the debris-removing coating, which are not disclosed by the prior art relied upon by the Examiner. At least for these reasons, dependent claims 8-12 are further allowable over the prior art relied upon by the Examiner.

Claims 21-29

Independent claim 21 of the present application is directed to a method for reducing printing contamination and includes providing a document having a first face, an opposing second face, and a debris-removing coating applied on at least a portion of the second face to remove printer debris during passage of the document through the printer. The method of claim 21 further includes passing the document through the printer for printing printing indicia upon at least a portion of the first face.

As previously provided herein with respect to independent claim 1, neither Muhr-Sweeney nor Tobol discloses a debris-removing document including, among other things, a substrate having at least a portion of a first face capable of receiving printing indicia. Because neither Muhr-Sweeney nor Tobol discloses a substrate having at least a portion of a first face capable of receiving printing indicia, neither Muhr-Sweeney nor Tobol discloses a method of reducing printer contamination using such a document as claimed. Accordingly, neither Muhr-

Sweeny nor Tobol, whether considered separately or in combination, discloses each and every feature of independent claim 21.

As such, Applicant respectfully submits that independent claim 21 is allowable over the prior art of record. Because independent claim 21 is allowable, claims 22-29 are also allowable at least for depending therefrom.

Moreover, dependent claims 22-29 are further allowable for reciting additional features not disclosed by the prior art relied upon by the Examiner. For example, claims 22 and 24 recite specific features of the document, claims 23, 25, and 26 recite specific features of the composition of the debris-removing coating, and claims 27-29 recite features of the contamination which are not disclosed by the prior art relied upon by the Examiner. At least for these reasons, dependent claims 22-29 are further allowable over the prior art relied upon by the Examiner.

New Claims

Applicant adds new claims 30-47 directed to features of the present application. Support for the new claims can be found throughout the present application.

New Claims 30-41. New claims 30-33 depend from independent claim 1, new claims 34-37 depend from independent claim 7, and new claims 38-41 depend from independent claim 21. Because independent claims 1, 7, and 21 are allowable, new claims 30-33, 34-37, and 38-41 are allowable at least for depending therefrom.

New Claims 42-47. New claim 42 is independent, and new claims 43-47 depend from new claim 42. New claim 42 is directed to a method for removing printer debris and is allowable over the prior art of record at least for the reasons previously provided herein. Because independent claim 42 is allowable, new claims 43-47 are allowable at least for depending therefrom.

Formal Request for Interview

Applicant requests an interview with the Examiner to discuss the present application and the prior art of record. The undersigned may be reached at telephone number (212) 294-3554 to schedule a mutually convenient date and time and to provide assistance or additional information as required.

CONCLUSION

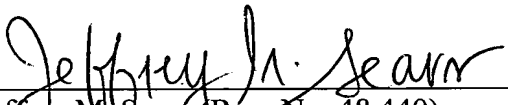
On the basis of the foregoing Amendment and Remarks, Applicant respectfully submits that the pending claims of the present application are allowable over the prior art of record. Applicant thus respectfully requests withdrawal of the previous rejections of the pending claims and timely allowance of claims 1-12 and 21-47.

Applicant authorizes the Commissioner to charge any additional fees and/or credit any overpayments associated with this paper to Winston & Strawn Deposit Account No. 50-1814, Ref. No. 8765-1100.

Further, if a fee is required for an extension of time under 37 C.F.R. § 1.136 not provided for above, Applicant requests such extension and authorizes the charging of the extension fee to Winston & Strawn Deposit Account No. 50-1814, Ref. No. 8765-1100.

Respectfully submitted,

Date: September 30, 2004


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